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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,076	10/21/2005	Toshio Tahira	63,128 (70904)	1859
21874 7590 06/30/2009 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
HORNING, JOEL G				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
06/30/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,076

Applicant(s)

TAHIRA ET AL.

Examiner

JOEL G. HORNING

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-46 and 48-58 is/are pending in the application.
4a) Of the above claim(s) 12-40 and 51-58 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6, 8-11, 41-46 and 48-50 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03-24-2005; 06-22-2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. In the amendment to claims filed 21st April 2009: claims 1, 6 and 10 were amended, claims 7 and 47 were cancelled and claims 12-40 and 51-58 are withdrawn.

Election/Restrictions

2. Claims 12-40 and 51-58 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21st April 2009.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 11, 42-46 and 48-50** are rejected under 35 U.S.C. 102(b) as being anticipated by Shimoda et al (JP-10-012377, english abstract as supplied by applicant).

The instant claims are product by process claims directed towards active matrix organic EL display elements deposited by an inkjet process. Wherein the inkjet device is an electrostatic attraction inkjet device, the nozzle hole in the inkjet is smaller than the droplet diameter, and the ink drops have a volume of 1pL or less. According to MPEP 2113: "even though product-by-process claims are limited by

and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”

Shimoda et al teaches making active matrix organic EL display elements using an inkjet process (**claims 11**), with an organic light emitting layer (**claims 44 and 49**) and charge transport layer (**claims 45, 50**) (abstract). How the inkjet device ejects the ink, whether the nozzle is smaller than the drop size, the volume of the drops, the volumetric concentration of the drops (**claims 42, 46 and 47**) and the viscosity of the ejected drops being 20cP or greater (**claims 43 and 48**) would not necessarily produce any structural change in the produced device, thus the active matrix organic EL display elements produced using the Shimoda et al method would be indistinguishable from those claimed and thus meets the above claim limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-6, 8-11, 41-46 and 48-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoda et al (JP10-012377, English abstract as supplied by applicant) in view of Higashino et al (US 6322198) in view of Chang et al (US 2002/0118251) in view of Hawkins et al (US 2002/0130931) in view of Seki et al (US 2002/0067123).

The instant claims are directed towards a method of producing an active matrix organic EL display element by using an inkjet method to form an organic EL layer from droplets of an organic EL layer material, wherein the inkjet device:

- a. is an electrostatic attraction type inkjet
- b. has an ejection hole diameter less than that of the liquid droplets
- c. produces droplets having a volume of 1 picoliter or less.

and the droplets are repeatedly ejected on a same organic EL layer so as to form a lamination with the droplets.

Shimoda et al teaches a method of forming an active matrix organic EL display by using an inkjet device in order to deposit layers of organic light emitting materials (abstract), which, as illustrated in figure 1(c), means that liquid drops of the organic EL material are deposited on the surface.

Shimoda et al does not specify what kind of inkjet method is used, so it does not appear to teach using an electrostatic type inkjet device.

However, Higashino et al is directed towards depositing films by inkjet methods and teaches using an inkjet device where electrostatic attraction between two electrodes causes the ink to eject (abstract). Higashino et al further teaches that this electrostatic attraction method of controlling jetting allows the volume of the ink droplet to be varied by controlling the potential over those electrodes (col 1, lines 59-64). Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use an electrostatic attraction type inkjet device in order to deposit the organic EL material layers of Shimoda et al since it was a known inkjet method, which would be suitable for depositing the inks and also because it would provide the additional advantage of being able to tune the volume of the droplets by controlling the potential over the electrodes.

Shimoda et al does not teach what the volume of the droplets or the size of the nozzle should be.

However, Chang et al teaches that reducing the volume of the drops ejected by inkjet devices allows for increased resolution of the produced image. To this end, they teach that inkjet devices with drop sizes less than 1pl are commercially available in order to produce high resolution images [0003].

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use drop sizes that are as small as possible, such as of 1pl or less with the process of Shimoda et al in order to increase the resolution of the produced pattern, which would allow for better quality patterning and the production of higher resolution displays to be made using the Shimoda et al method.

Shimoda et al also does not teach what the size of the ink injection nozzle is.

However, Hawkins et al teaches that in inkjet devices, the diameter of the nozzle is a result effective variable for determining the flow of ink through the nozzle and thus the droplet size [0094].

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to choose the instantly claimed nozzle with a "diameter smaller than a diameter of the droplets" through process optimization, since it has been held that when the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Regarding the limitation that multiple droplets be ejected on the same organic EL layer so as to form a lamination. Shimoda et al teaches laminating the light emitting layers onto a hole injection layer by ink jet deposition (abstract) and person

of ordinary skill in the art will always choose to make the deposited organic EL film the thickness that is desired. The thickness of the organic EL film is the volume of organic EL material that composes the film divided by the surface area over which the film is deposited. Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to calculate the volumetric concentration of organic EL material in the liquid such that the volume of organic EL material deposited by each drop on the surface adds up to the desired thickness. Such a person would do so because to do otherwise would be undesirable (**claim 1**).

6. Regarding **claim 6**, the amount of solute present in a given volume of solvent (e.g. the volumetric concentration of that EL material in the fluid) is the amount of solute deposited when the solvent is removed. Thus, increasing the volumetric concentration of EL material will make the deposited layer thicker and the volumetric concentration of the EL material in the fluid is a result effective variable for determining the thickness of the resulting film.

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to choose the instantly claimed ranges of volumetric concentration substantially equal to $\frac{(\beta \times t)}{(\alpha \times D)}$ through process optimization, since it has been held that when the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

7. Regarding **claims 3 and 8**, Shimoda et al does not teach what the viscosity of the liquid is. However, Hawkins et al teaches that the fluid viscosity is a result effective variable for determining the size of the produced droplet [0094].

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to choose the instantly claimed ranges of a "viscosity of 20cP or greater" through process optimization, since it has been held that when the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

8. Regarding **claims 4 and 9**, Shimoda et al teach that layers of organic light emitting material are part of the organic EL layer that is deposited (abstract).
9. Regarding **claims 5, 10 and 41**, Shimoda et al further teaches applying a charge transport layer (positive hole injection layer) as part of the organic EL layer (abstract).
10. **Claims 11, 42-46 and 48-50** are alternately rejected as obvious end products resulting from obvious modifications to the process of Shimoda et al.

Response to Arguments

11. Applicant's arguments filed 21st April 2009 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the droplets are dried immediately after landed on an organic EL layer formation

rejoin on a substrate, preventing movement of the droplets landed on another droplet having previously landed", page 25) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that having droplets of 1pL or less in volume permits a "high speed of drying the droplets, high accuracy in landing the droplets, easiness in ejecting the droplets, and a large number of landed droplets" (page 25), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

12. No current claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOEL G. HORNING whose telephone number is (571) 270-5357. The examiner can normally be reached on M-F 9-5pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael B. Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. G. H./
Examiner, Art Unit 1792

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1792